

Appl. No. 10/787,018
Amdt. dated January 4, 2006
Reply to Office Action of October 5, 2005

PATENT

REMARKS/ARGUMENTS

After entry of this amendment, claims 37-50 are pending, claim 38 having been amended herein.

Amendments to the Specification and Claims

The specification has been amended to indicate the present status of related applications. No new matter is added by these amendments, which merely provide the U.S. patent number for U.S. Patent Application No. 09/721,495, which issued after the filing date of the present application, and the abandoned status for U.S. Patent Application No. 09/686,019.

Claim 38 has been amended to recite "CCX CKR" for clarity. Support is provided in claim 37. No new matter is added by this amendment.

Claim Rejection - Double Patenting

Claims 37-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,835,547 (the '547 patent). The '547 patent is the parent of the instant application. The Examiner alleges that the conflicting claims, although not identical, are not patentably distinct. The Examiner also alleges that claims 37-50 are anticipated by claim 12 of the '547 patent. Applicants respectfully traverse this double patenting rejection for the following reason.

As an initial matter, Applicants do not understand the Examiner's allegation that claims 37-50 are anticipated by claim 12 of the '547 patent. Claim 37 of the instant application is directed to a process of providing a pharmaceutical composition, comprising conducting the steps of identifying a modulator of CCX CKR *binding*, and thereafter formulating the modulator. Claim 12 of the '547 patent is directed to a process of providing a pharmaceutical composition, comprising conducting the steps of identifying a modulator of CCX CKR *activity*, and thereafter formulating the modulator. Clarification is respectfully requested.

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The grandparent application, U.S. Patent Application No. 09/686,019 (the '019 application) was subject to restriction under 35 U.S.C. § 121. The Examiner determined that there were 9 separate, patentably distinct inventions disclosed in the '019 application. The '547 patent is continuation of the '019 application. A related application, U.S. Patent Application No. 0909/686,020 (the '020 application), filed the same day as the '019 application, was also subject to restriction under 35 U.S.C. § 121. A different examiner determined that there were 14 separate, patentably distinct inventions disclosed in the '020 application. For both the '019 and '020 applications, the examiners determined that the claim directed to a process of providing a pharmaceutical composition, comprising conducting the steps to identify a modulator of CCX CKR *activity* and thereafter formulating the modulator, was in a different restriction group, and therefore patentably distinct, from the claim directed to a process of providing a pharmaceutical composition, comprising conducting the steps to identify a modulator of CCX CKR *binding* and thereafter formulating the modulator. Because these two types of process claims were deemed to be patentably distinct in both the '019 and '020 applications, and the '547 patent is a continuation of the '019 application, it is respectfully submitted that the instant claims are patentably distinct from claim 12 in the '547 patent. Accordingly, Applicants respectfully request that the double patenting rejection be withdrawn.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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Attachments
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